



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicants: Ron S. Israeli et al.

Serial No.: 08/470,735

Group Art Unit: 1649 AUG 4 2004

Filed: June 6, 1995

Examiner: S. Gucker

OFFICE OF PETITIONS

For: PROSTATE-SPECIFIC MEMBRANE ANTIGEN

1185 Avenue of the Americas
New York, New York 10036
July 30, 2004

Date of Notice

Of Allowance: April 20, 2004

Confirmation No.: 7764

VIA HAND

U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop Petition
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

ATTN: Director of Technology Center 1600

Sir:

**COMMUNICATION SUPPLEMENTING JUNE 16, 2004 PETITION TO
WITHDRAW FROM ISSUE AT THE INITIATIVE OF THE
APPLICANT UNDER 37 C.F.R. §1.313(a) INCLUDING SECOND
SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

This Communication is submitted to supplement the Petition To Withdraw From Issue At The Initiative Of The Applicant Under 37 C.F.R. §1.313(a) filed June 16, 2004 with the United States Patent and Trademark Office in connection with the above-identified application. A Notice of Allowance was issued April 20, 2004 in connection with this application requiring that applicants submit (i) the issue fee and (ii) new formal drawings by July 20, 2004. Prior to paying the issue fee, applicants on June 16, 2004 filed (A) a Petition To

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Withdraw From Issue At The Initiative Of The Applicant Under 37 C.F.R. §1.313(a), including a Supplemental Information Disclosure Statement, and (B) an Amendment After Notice Of Allowance Pursuant To 37 C.F.R. §1.312. No action has yet been taken on either the Rule 313(a) Petition or Rule 312 Amendment. Therefore, applicants maintain that this Communication is timely submitted.

REMARKS

Related Facts

On April 29, 2004, the undersigned office received an Office Action issued April 27, 2004 by the United States Patent and Trademark Office in connection with U.S. Application Serial No. 09/990,595, a continuation of the subject application. The April 27, 2004 Office Action included a Notice Of References Cited (PTO-892) which cited U.S. Patent No. 4,939,240 issued on July 3, 1990 to Chu, et al. A copy of Chu et al. is attached as **EXHIBIT 1** to the Second Supplemental Information Disclosure Statement attached hereto as **EXHIBIT A**.

On May 5, 2004, the undersigned forwarded to the client and to legal representatives of a licensee and a sublicensee a copy of the April 27, 2004 Office Action, including a copy of Chu et al.

On June 16, 2004 applicants filed a Petition To Withdraw From Issue At The Initiative Of The Applicant Under 37 C.F.R. §1.313(a) in connection with the subject application, seeking to have the subject application

withdrawn from issue in order that four references cited in a March 2, 2004 Official Action issued by the Japanese Patent Office in connection with corresponding Japanese Patent Application No. 511426/94 be considered. Applicants also concurrently filed an Amendment After Notice Of Allowance Pursuant To 37 C.F.R. §1.312. No action has yet been taken with respect to either the Rule 313(a) Petition or the Rule 312 Amendment.

On July 20, 2004, applicants also filed a Petition To Withdraw From Issue At The Initiative Of The Applicant Under 37 C.F.R. §1.313(a) and an Amendment After Notice Of Allowance Pursuant To 37 C.F.R. §1.312 in connection with U.S. Application Serial No. 08/481,916, which shares a common chain of priority with U.S. Application Serial No. 09/990,595 in that both claim priority to U.S. Application Serial No. 07/973,337. Neither the Petition nor the Rule 312 Amendment in connection with U.S. Application Serial No. 08/481,916 has been acted on.

On July 26, 2004, a legal representative of the sublicensee of the subject application notified Cindy Yang, Esq., an associate in the undersigned's law firm, that Chu et al. should be considered in terms of making it of record in the subject application.

Action Requested

Applicants hereby request that this Second Supplemental Information Disclosure Statement under 37 C.F.R. §1.97, attached hereto as **EXHIBIT A**, including the Form PTO-1449 attached thereto as **EXHIBIT A** to the Second Supplemental

Information Disclosure Statement, be considered together with their June 16, 2004 Petition and the Supplemental Information Disclosure Statement submitted therewith, so that Chu et al. may also be considered and made of record by the Patent Office in addition to the four references from the Japanese Patent Office previously submitted.

Applicants are filing this Communication promptly after becoming aware of the desirability of making Chu et al. of record in this application and prior to a decision on their June 16, 2004 Petition.

Applicants maintain that they have already paid the required fee in connection with the June 16, 2004 Petition and have already made a showing of good and sufficient reasons why withdrawal of the application from issue is necessary. Therefore, applicants again request in the interest of justice that their June 16, 2004 Petition be granted and both the Supplemental Information Statement submitted with their June 16, 2004 Petition and the Second Supplemental Information Disclosure Statement enclosed herewith be considered.

Summary

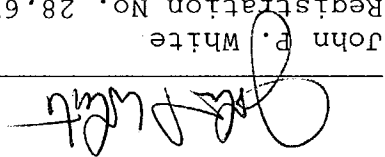
For the foregoing reasons, applicants earnestly solicit an expeditious withdrawal from issue of the subject application under 37 C.F.R. §1.313(a) and look forward to receiving from the Director of Technology Center 1600 a communication to this effect.

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If a telephone conference would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee is deemed necessary in connection with the filing of this Communication. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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